



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,974	02/06/2004	Roger Scott Twede	200207902-1	7106
22879 7590 01/11/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER TRUONG, THANHNGA B	
			ART UNIT 2135	PAPER NUMBER
			NOTIFICATION DATE 01/11/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
mkraft@hp.com
ipa.mail@hp.com

Office Action Summary

Application No.

10/773,974

Applicant(s)

TWEDE, ROGER SCOTT

Examiner

Thanhnga B. Truong

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10,11 and 19-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-8, 10-11, 19-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the communication filed on October 08, 2007. Claims 1-2, 4-8, 10-11, 19-39 are pending. Claims 3, 9, and 12-18 are canceled by the applicant. At this time, claims 1-2, 4-8, 10-11, 19-39 are still rejected.

Response to Arguments

2. Applicant's arguments with respect to claims 1-2, 4-8, 10-11, 19-39 under 35 USC 102 have been considered but are moot in view of the new ground(s) of rejection. However, upon further consideration, an additional new ground(s) of rejection under 35 USC 101 is made in view of the specification.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 33-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

a. *Referring to claim 33:*

i. Claim 33 recites "A computer-readable medium having a program available thereon for causing a suitably programmed information-handling system to transport documents between a first imaging device and a second imaging device by performing the following when such program is executed on the information-handling system: encrypting an original document; transmitting the original document from the first imaging device to the second imaging device, such that the second imaging device receives an image of the original document, wherein the second imaging device is under control of the recipient; transmitting an acknowledgment of receipt of an the image of the original document from the second imaging device; and destroying the original document at the first imaging device in response to receiving the acknowledgment from the second imaging device, such that the original document is destroyed at the first imaging device only after the first imaging device has been assured that the second imaging device has received the image of the original

document.” The claim is directed toward a software program, and this is a non-statutory subject matter. Furthermore, applicant has pointed out in the specification (see page 2, lines 19-24 of specification) **“the functions described herein are implemented in software in one embodiment, where the software comprises computer executable instructions stored on computer readable media such as memory or other type of storage devices. The term “computer readable media” is also used to represent carrier waves on which the software is transmitted. Further, such functions correspond to modules, which are software, hardware, firmware of any combination thereof,”** which clearly including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. Therefore, claim 33 recites a non-statutory subject matter.

b. Referring to claim 35:

i. These claims consist a apparatus for transporting a document to implement claim 33, thus they are rejected with the same rationale applied against claim 33 above.

c. Referring to claims 34, 36-39:

i. These claims are dependent claims of 33 and 35, thus they are rejected with the same rationale applied against claims 33 and 35 above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-8, 10-11, 19-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botham et al (US 6,785,812 B1), in view of Ginter et al (US 6,185,683 B1), and further in view of Holloway et al (US 5,912,974).

a. Referring to claim 1:

i. Botham teaches a method of transporting a document comprising:

(1) encrypting an original document; transmitting an image the original document to a system of a recipient (**see Figure 2 and column 2, lines 6-12 of Botham**); assuring that the system of the recipient has received transmission of the image of the original document (**see last sentence of the abstract of Botham and column 2, lines 32-34; column 4, lines 9-10 and lines 34-35 of Botham**);

(2) destroying the original document at a system of a sender after transmitting the image of the original document to the system of recipient, where the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient transmission of the image of the original document (**column 4, lines 9-10 and lines 34-35 of Botham**);

(3) decrypting the image of the original document (**see Figure 2 and column 2, lines 14-15 of Botham**);

(4) printing a copy of the image of the original document at the system of the recipient (**column 2, lines 50-54 of Botham**); and

(5) certifying that the copy of the image of the original document was received from a sender, by at least a public notary notarizing the copy of the image of the original document as has been printed (**column 2, lines 32-34 of Botham**).

ii. Although Botham teaches the claimed subject matter, Botham is silent on the capability of showing the destroyed document is at the system of the sender and by at least a public notary notarizing the copy of the image of the original document. On the other hands, Ginter teaches the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient transmission of the image of the original document (**column 8, lines 12-14 of Ginter**) and Holloway teaches by at least a public notary notarizing the copy of the image of the original document (**column 1, lines 21-22 of Holloway**).

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Botham with the teaching of Ginter and Holloway to improve the electronic distribution of information (**column 1, lines 6-7 of Botham**).

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Botham with the teaching of Ginter and Holloway for securing and controlling electronic document distribution arrangement (**see Botham's tile**).

b. Referring to claim 2:

i. Botham further teaches:

(1) assuring that the system of the recipient is enabled to receive a transmission (**column 2, lines 32-34 of Botham**).

c. Referring to claim 4:

i. Botham further teaches:

(1) placing the received transmission in a storage device of the system of the recipient, wherein the public key of the sender is used by the

recipient to access the image of the original document in the storage device (**column 2, lines 1-5 of Botham**).

d. Referring to claim 5:

i. Botham further teaches:

(1) adding a global universal identification to the encrypted original document (**column 4, lines 10-18 of Botham**).

e. Referring to claim 6:

i. Botham further teaches:

(1) wherein the global universal identification includes a time component and a unique machine identifier (**column 4, lines 10-18 of Botham**).

f. Referring to claim 7:

i. Botham further teaches:

(1) wherein the unique machine identifier is a machine address code (MAC) (**column 4, lines 10-18 of Botham**).

g. Referring to claim 8:

i. Botham further teaches:

(1) notarizing the original document (**column 4, line 16 of Botham**).

h. Referring to claim 10:

i. Botham further teaches:

(1) wherein encrypting an original document further comprises use of a private key of the sender (**column 2, lines 1-5 of Botham**).

i. Referring to claim 11:

i. Botham further teaches:

(1) wherein encrypting an original document further comprises use of a public key of a recipient (**column 2, lines 1-5 of Botham**).

j. Referring to claim 19:

i. This claim consists an imaging apparatus to implement claim

1, thus it is rejected with the same rationale applied against claim 1 above.

k. Referring to claims 20-22:

i. These claims have limitations that are similar to those of claims 1-4, thus they are rejected with the same rationale applied against claims 1-4 above.

l. Referring to claims 23-32:

i. These claims have limitations that are similar to those of claims 1-18, thus they are rejected with the same rationale applied against claims 1-18 above.

m. Referring to claims 33-34:

i. These claims consist a computer-readable medium having a program available thereon for causing a suitably programmed information-handling system to transport documents between a first imaging device and a second imaging device by performing the following when such program is executed on the information-handling system to implement claims 1 and 4, thus they are rejected with the same rationale applied against claims 1 and 4 above.

n. Referring to claims 35-39:

i. These claims consist an apparatus for transporting a document to implement claims 1-4, thus they are rejected with the same rationale applied against claims 1-4 above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone

Application/Control Number:
10/773,974
Art Unit: 2135

Page 8

numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.



TBT

January 04, 2008

THANHNGA TRUONG
PRIMARY EXAMINER